

REMARKS

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Reply Brief.
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The Examiner's Answer states that the drawing objection should be addressed by petition rather than appeal. However, all of the issues of patentability are inextricably connected to the Examiner's position with respect to the drawing. The alleged lack of disclosure in the drawings is the grounds for the new matter rejection under 35 U.S.C. §112, first paragraph, as well as the drawing rejection under Rule 83(a). Indeed, the Examiner's position with respect to the alleged lack of disclosure (i.e., "new matter") likewise leads to the Examiner's position as to the priority date thereby giving rise to the rejections under 35 U.S.C. §102(e). Therefore, any petition with respect to the drawing objection would have improperly entailed a patentability analysis with respect to 35 U.S.C. §112, first paragraph and 35 U.S.C. §102(e).¹ Therefore, in the words of the CCPA in In re Haas, 179 U.S.P.Q. 623, 626 (CCPA, 1973), "An examiner's adverse action of this nature *is* a rejection, a denial of substantive rights. Review thereof must fall within the jurisdiction of the board". (italicization in original)

Additionally, the Examiner's Answer notes that the Appeal Brief does not "dispute the rejection that the Buchman patents anticipate applicant's claim". However, the presently pending claim is copied from a related Buchman patent – U.S. Patent No. 6,290,391 – for the purpose of provoking an interference. The Appellant's position is that the Appellant is entitled to a filing date earlier than that of the Buchman references and that priority between the Buchman '391 reference and the present application should be decided by interference. As such, the Appeal Brief would be an inappropriate forum for distinguishing over the Buchman references. In other words, the Buchman references are not properly cited as prior art and the Buchman references therefore do not "anticipate" the presently pending claim.

¹ As noted on page 5 of the Appeal Brief, "all of the rejections are based on the same unsupported finding of the Office Action, and the reversal of this unsupported finding will lead to the reversal of all of the rejections."